

**REMARKS**

Claims 1-14 are currently pending in the application. By this response, no claims are amended, added, or canceled. Applicants respectfully request reconsideration in view of the following remarks.

***Provisional Double Patenting Rejection***

Claims 1-14 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/932,337 (the '337 application). This rejection is respectfully traversed.

Initially, Applicants note that this is a provisional double-patenting rejection. Since this is a provisional rejection, Applicants are not required to provide any comments as to whether the claims of the instant application are obvious in view of the claims of the '337 application, and are not providing a terminal disclaimer at this time. However, in a good-faith effort to advance prosecution, Applicants provide the following response.

The Examiner provides the following explanation of the provisional double patenting rejection:

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art to rearrange parts of the invention.

Applicants respectfully disagree with this rejection because (i) the explanation fails to establish a *prima facie* case of obviousness-type double patenting, and (ii) claims 1-14 of the present invention recite features that are not recited in claims 1-10 of the '337 application.

First, the above-noted explanation fails to establish a *prima facie* case of obviousness-type double patenting. According to MPEP §804, an obviousness type double patenting

rejection must be made in light of the 35 U.S.C. §103(a) factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). More specifically,

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of the invention defined in a claim in the patent.

(MPEP §804)

Applicants submit that the above-noted explanation of the double patenting rejection fails to make clear the differences between the inventions defined by the conflicting claims. The explanation includes no comparison of the claims in the ‘337 application and the claims of the instant application. The Examiner’s contention that it would have been obvious to rearrange parts does not serve to adequately address and compare the features recited in the claims, as required by MPEP §804. Therefore, the rejection is improper on its face, and should be withdrawn for this reason alone.

In any event, Applicants submit that claims 1-14 of the present invention recite features that are not recited in claims 1-10 of the ‘337 application. For example, claim 5 of the present application recites the board is ground; however, this is not recited in any of claims 1-10 of the ‘337 application. Additionally, claims 8 and 9 of the present application recite mixing/scattering at least one of antibacterial and antistatic additives; however, antibacterial and antistatic additives are not recited in any of claims 1-10 of the ‘337 application. Also, claim 11 of the present application recites providing a filler comprising wood fiber, wood dust, metals, mineral substances, plastics, or ash; however, such a filler is not recited in any of claims 1-10 of the ‘337 application. Therefore, the double patenting rejection is improper because at least claims 5, 8, 9,

and 11 of the present application recite features that are not recited or suggested by claims 1-10 of the '337 application.

Accordingly, Applicants respectfully request that the provisional rejection over claims 1-14 be withdrawn.

### **35 U.S.C. §102 Rejection**

Claims 1-14 were rejected under 35 U.S.C. §102(b) as being anticipated by EP '953 (presumably EP 0 574 953 A1, cited in the Information Disclosure Statement filed October 14, 2005). This rejection is respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131. Applicants submit that the applied art does not show each and every feature of the claimed invention.

The invention generally relates to a wooden board and a process for finishing a wooden board, in particular an MDF or HDF board with an upper side and an underside. These boards may be used, for example, for furniture construction and panels, in particular flooring panels. In exemplary embodiments of the invention, a board is produced using the following steps: applying a sealing layer of melamine resin to the upper side of the board, printing a decoration onto the sealing layer, applying a protective layer of melamine resin to the decoration, and pressing the board under the action of temperature until the protective layer and the sealing layer melt and bond to each other with the inclusion of the decoration printed on. By printing the decoration on the melamine resin sealing layer, a printed paper layer can be eliminated, thereby

avoiding the problems associated with paper growth. More specifically, independent claim 1 recites:

- a) applying a sealing layer of melamine resin to the upper side of the board,
- b) printing a decoration onto the sealing layer,
- c) applying a protective layer of melamine resin to the decoration

The Examiner asserts that EP '953 discloses all of the features of the claimed invention at lines 20-58 of page 2, lines 1-35 of page 6, lines 20-58 of page 7, and lines 29-48 of page 8. Applicants respectfully disagree, and submit that EP '953 does not disclose many features of the claimed invention.

EP '953 is directed to a method of designing dies (i.e., pressing plates), which are used for forming wood composite panels having patterns embossed thereon. This reference has absolutely nothing to with a method of finishing a wood board, itself. At pages 2 and 6, EP '953 describes the construction of a typical oriented strand board (OSB). At pages 7 and 8, EP '953 describes dies which can be used during pressing of the fibers of the OSB to produce embossed patterns (i.e., raised and/or depressed regions) in the surfaces of the finished OSB. However, obviously missing from this reference is a method as recited by the claimed invention of finishing a wood board.

Specifically, EP '953 does not disclose applying a sealing layer of melamine resin to the upper side of the board, printing a decoration onto the sealing layer, or applying a protective layer of melamine resin to the decoration, as recited in claim 1. To the contrary, EP '953 only discloses forming the board itself, and makes no mention of applying melamine resin layers and printing a decoration on one of the melamine resin layers. In fact, EP '953 does not even use the word "melamine," and makes absolutely no reference whatsoever to printing a decoration.

Instead, EP '953 merely describes embossing a pattern (i.e., a structural relief) in the surface of an OSB. This, however, in no way constitutes the features recited in claim 1. In fact, embossing a pattern is much different than printing. Embossing connotes physical indentation in the panel, whereas printing constitutes applying a decoration, e.g., with ink. Therefore, EP '953 does not disclose all of the features of the claimed invention.

Claims 2-14 depend from independent claim 1, and are allowable based upon the allowability of claim 1. Moreover, claims 2-14 recite additional features that are not disclosed by EP '953. For example, claim 2 recites applying a sealing layer of melamine resin to the underside of the board, applying a colored layer to the sealing layer on the upper side of the board, and applying the protective layer of melamine resin to the decoration. As discussed above with respect to claim 1, EP '953 makes no mention of applying melamine resin layers to a side of a board, or of applying a colored layer to a melamine resin layer.

Claim 5 recites the board is ground before the sealing layer is applied. EP '953 does not disclose the board is ground. Instead, EP '953 only discloses pressing fibers of an OSB together between dies. Moreover, the Examiner has not provided any explanation of how or where EP '953 discloses the features of this claim.

Claims 6 and 7 recite providing/scattering corundum into/onto a layer of the melamine resin. EP '953 does not disclose corundum, much less providing/scattering corundum into/onto a layer of resin. Moreover, the Examiner has not provided any explanation of how or where EP '953 discloses the features of these claims.

Claims 8 and 9 recite mixing/scattering at least one of antibacterial and antistatic additives into/onto a layer of the melamine resin. EP '953 does not disclose antibacterial or antistatic additives, much less mixing/scattering at least one of antibacterial and antistatic

additives into/onto a layer of resin. Moreover, the Examiner has not provided any explanation of how or where EP '953 discloses the features of these claims.

Claim 10 recites providing at least one filler into at least one of the sealing layer [of melamine resin] and the protective layer [of melamine resin]. Claim 11 depends from claim 10, and recites the filler is wood fibers, wood dust, metals, mineral substances, plastics, or ash. EP '953 does not disclose any filler material provided in a layer of melamine resin. Moreover, the Examiner has not provided any explanation of how or where EP '953 discloses the features of these claims.

Therefore, as described above, the applied art does not disclose many features of the claimed invention, and cannot reasonably be said to anticipate claims 1-14. Accordingly, Applicants respectfully request that the §102 rejection of claims 1-14 be withdrawn.

### CONCLUSION

In view of the foregoing remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

Respectfully submitted,  
Frank OLDORFF

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', written over a horizontal line.

Andrew M. Calderon  
Reg. No. 38,093

August 27, 2007  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191